Request for Reconsideration under 37 C.F.R. § 1.116 Attorney Docket No. Q60879
U.S. Application No.: 09/680,419

REMARKS

Claims 1-15 are all the claims pending in the application.

The Examiner rejected claims 1 and 3-15 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter "APA") in view of a newly found reference, USP 6,674,955 to Matsui et al. (hereinafter "Matsui"). The Examiner indicated that claim 2 contains allowable subject matter.

Claim Rejections

Claims 1 and 3-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over APA in view of Matsui. The Examiner's careful reconsideration is submitted to be appropriate in view of the following comments traversing the rejection.

To begin, it is respectfully submitted that there is no motivation to combine the APA and Matsui in the manner suggested by the Examiner (see page 3 of the Office Action). A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (*citing In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (*quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

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Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, ***identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention***. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

"Although the suggestion to combine references may flow from the nature of the problem, 'defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" *Exolochem, Inc. v. Southern California Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (*citing Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). "Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at 29-30 (*citing In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must

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nevertheless be "clear and particular. *Winner International Royalty Corporation v. Ching-Rong Wang*, 202 F.3d 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000) (citations omitted).

APA is directed to a display for indicating the operated condition of a controller which coordinates and controls the operation of a controlled system such as the industrial equipment, the production line or the chemical plant. The controller holds the signal and data of the controlled system and classifies it into an input signal, an output signal, a count value, a timer value and a numerical data. These signals and data are examples of devices. They are stored in memory and are controlled by a control program, which specifies the operation of the controlled system. To inform the device values of the controller to the operator on a production line, a display is used to display device data. These display screens are drafted by designers. In short, the APA is directed to a drafting apparatus, which indicates the operating conditions of the devices of the controller and a control program that specifies the control operations of the controlled system.

Matsui, on the other hand, teaches an editing apparatus for processing a video signal and an audio signal supplied as a source materials to select the desired scenes for broadcasting (col. 1, lines 50 to 57). In particular, Matsui teaches a graphical user interface for editing the video and audio signal. The user interface has three windows, a viewer window 92, a log window 93 and a program window 94 (Fig. 12; col. 24, lines 23 to 57). The viewer window 92 allows the operator to select a source device via selection buttons 102 and then, while viewing the video signal from the source device, to set an in-point and an out-point for editing material reproduced from the source device (Fig. 13; col. 24, line 59 to col. 25, line 13). The source devices are the daily server 6, the VTR 7, the local storage 8, the auxiliary input portion AUX, and the internal

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input INT. When editing video data, the operator simply clicks on a source selecting button (102A-102E), and a corresponding source device (the daily server 6, the VTR 7, the local storage 8, the auxiliary input portion AUX, or the internal input INT) is selected (col. 25, lines 27 to 39).

In short, Matsui teaches creating video clips for broadcasting, whereas the APA deals with a display for indicating the operation condition of a controller system. The two references are unrelated and one of ordinary skill in the art confronted with a problem of memorizing a device when drafting display information for these devices and a control program for operation of these devices would never have turned to a reference like Matsui. Matsui's editing device is from a different field of endeavor, and it addresses a completely different problem (being able to quickly edit different video data such as sports and news). The selection of a source device, as taught by Matsui, is for acquiring a video data stored at that particular device.

Matsui has nothing to do with drafting display information for the device or a control program for the selected device. In Matsui, the selection must occur before the editing because the video data to be edited must first be selected. Matsui's source devices are nothing more than memory where the video data to be edited is stored, whereas the APA deals with creating the display information for these devices. In the APA, it is customary to first draft the display information and then select the device to which this information is to be applied (e.g., Fig. 25).

In short, it is respectfully submitted that one of ordinary skill in the art confronted with the problem of memorizing the devices for which the display information and the control program is drafted would never have turned to a reference like Matsui, which is an editing system for video data and has nothing to do with the problem of memorizing the devices or with

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creating display information for the device of a controller, and could not have effectively combined the two radically different systems at all, let alone in the manner thought by the Examiner to be obvious. In short, there was no motivation to combine the references in the manner indicated by the Examiner.

Moreover, of the rejected claims, only claims 1, 6 and 9 are independent. Independent claim 1 recites: *wherein the means for selecting are used to select a device before the means for setting up are used to set up the display drafting information.* The Examiner asserts that claim 1 is directed to a display drafting apparatus and is unpatentable over APA in view of Matsui. The Examiner acknowledges that APA does not teach or suggest selecting the device before setting up the display drafting information for the device (see page 3 of the Office Action). However, the Examiner alleges that Matsui cures the deficient teachings of APA. In particular, the Examiner alleges that Matsui teaches selecting a source device before setting up a display, as set forth in claim 1 (see page 3 of the Office Action). This ground of rejection is respectfully submitted to be incorrect as a technical matter. Matsui's discussion of selecting a source device and setting up the display has been carefully studied and such teachings of Matsui are very dissimilar to selecting a device before setting up the display, as set forth in claim 1.

For example, an illustrative, non-limiting embodiment of the present invention, teaches a display for indicating the operated condition of a controller which coordinates and controls the operation of a controlled system such as the industrial equipment, the production line or the chemical plant. In other words, the means for setting up display drafting information in this exemplary embodiment sets up a display for drafting information (operational conditions) for the

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device. This passage is provided by way of an example only and is not intended to limit the scope of the claims in any way.

Matsui teaches an editing apparatus for processing a video signal and an audio signal supplied as a source materials to select the desired scenes for broadcasting (col. 1, lines 50 to 57), as explained above. In Matsui, the video data, which is to be edited is selected by selecting a source device that stores this video data. In other words, Matsui's source device is nothing more than a simple memory storage.

The relevance of Matsui is not understood, as it relates to creating video clips of an audio and video signal stored in various devices. Matsui teaches selecting a source device on which the video to be edited is stored. That is, the user selects a source device where the video is stored and reproduces this video on the display for further editing by the operator. However, Matsui does not teach or suggest selecting a source device for which a display drafting information is to be drafted. Matsui only teaches the selection of video data to be edited by selecting a source device on which the data is stored. Matsui is not even remotely related to a programmable controller and fails to teach or suggest selecting devices of the controller before drafting display information for the selected devices. In short, Matsui fails to teach or suggest means for selecting a device of the controlled before setting up the display drafting information for the selected device within the meaning of claim 1.

Therefore, *the means for selecting, used to select a device before the means for setting up are used to set up the display drafting information...*, as set forth in claim 1 is not suggested or taught by the combined teachings of the APA and Matsui, which lack selecting a device of a

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controller before setting up the display area for the selected device. For at least these reasons, independent claim 1 is patentable over the APA and Matsui, taken alone or in any conceivable combination. It is, therefore, appropriate and necessary for the Examiner to withdraw this rejection of independent claim 1. Claims 3-5 are allowable at least by virtue of their dependency on claim 1.

In addition, the Examiner alleges that APA teaches the recitation of the dependent claim 3 (see page 3 of the Office Action). This ground of rejection is respectfully submitted to be incorrect as a technical matter. Claim 3 recites: *means for allowing the device selection information for said controller selected and created by said device selecting means to be used with said control program schema generator*, and its base claim 1 recites using the selected device for the display drafting. The Examiner alleges that Fig. 22 and page 2, lines 2-10 of the APA teaches the recitation of claim 3 (see page 3 of the Office Action).

However, Fig. 22 simply shows a ladder diagram and the corresponding passage describes the Fig. 22 as being a user operation screen for the control program schema generator. However, there is no teaching or suggestion in the APA that the devices shown in Fig. 22 are the same devices that are used by the display drafting information. In other words, the APA clearly fails to teach or suggest selecting a device for both the display information drafting and control program generation, e.g. see page 8 of the Specification. Matsui only teaches an editing apparatus for a video and fails to teach or suggest drafting a control program for the controller. As such, Matsui fails to cure the deficient teachings of the APA. For at least this additional exemplary reason, dependent claim 3 is patentable over the APA and Matsui.

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Similarly, with respect to the dependent claim 4, it is respectfully submitted that APA fails to teach or suggest *means of sharing the appended comment between the display drafting apparatus and the control program schema generator*, as set forth in the dependent claim 4. In fact, the APA teaches just the opposite. APA teaches that information between the control program and the drafting display is not shared, and as a result it must be temporarily memorized by the user or jotted down on a piece of paper, when switching between the display drafting means and the control program generation means (e.g., pages 6 and 9 of the Specification). For at least this additional reason, it is appropriate and necessary for the Examiner to withdraw this rejection of the dependent claim 4 or to at least explain how the APA which discusses the problem of not being able to share information between the control program designing and the display information drafting, as explained in pages 6-8 of the specification, teaches this feature.

Next, this rejection is addresssed with respect to the independent claim 6. Independent claims 6 recites:

> means for allowing the use of the device selection information for said controller selected and created by said device selecting means, when a program schema is generated by said generating means,
>
> wherein the means for selecting of the display drafting apparatus are used to select a device before the means for setting up of the display drafting apparatus are used to set up the display drafting information.

The Examiner alleges that APA teaches the means for allowing the use of the device selection information for the controller, as set forth in claim 6 and that Matsui teaches means for using a display drafting apparatus to select a device before the means for setting up the display drafting

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apparatus are used, as set forth in claim 6 (see page 4 of the Office Action). This ground of rejection is submitted to be incorrect as a technical matter.

As explained hereinabove, APA clearly fails to teach or suggest the sharing of data between the drafting apparatus and a control program schema generation means. In fact, the APA teaches that, since the means for setting up display drafting information is separate from the control program schema generation, the device must be selected twice, once for the display drafting and another time for the control program (e.g. page 8, lines 7 to 16). Moreover, with respect to selecting a device before setting up the display drafting information as recited in claim 6, this recitation is somewhat similar to the recitation argued above with respect to claim 1. Since claim 6 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here.

For at least these reasons, therefore, it is appropriate and necessary for the Examiner to withdraw this rejection of independent claim 6 and its dependent claims 7-8. In addition, with respect to the dependent claims 7 and 8, the Examiner alleges that the connection of the three devices are taught by the APA and that the order of the connection is an obvious design choice (see page 6 of the Office Action). However, it is respectfully pointed out that the Examiner failed to address how the combination of the APA and Matsui teaches the transferring means for transferring drafting data to the drafting apparatus, the controller and the display.

It is respectfully noted that the APA teaches that one of the problems of the conventional devices is the inability to share data between the drafting display information and the control program schema generation. As such, the APA clearly fails to teach or suggest the transfer of drafting data between the drafting apparatus and the control program. Matsui fails to cure the

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deficient teachings of the APA. In short, the combined teachings of the APA and Matsui fail to suggest the transferring means as set forth in claims 7 and 8. For at least this additional reason, dependent claims 7 and 8 are patentable over the combined teachings of the APA and Matsui.

Finally, this rejection is addressed with respect to independent claim 9. Claim 9 recites *setting up a display drafting information for said selected device after said device is selected.* This recitation is similar to the recitation argued above with respect to claim 1. Since claim 9 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially the same reasons, therefore, it is appropriate and necessary for the Examiner to withdraw this rejection of independent claim 9 and its dependent claims 10-15.

Allowable Subject Matter

The Examiner indicates that claim 2 would be allowable if rewritten in the independent form including all the limitations of the base claim and any intervening claims. The rewriting of claim 2 is respectfully held in abeyance until the arguments presented with respect to the independent claim 1 have been reconsidered.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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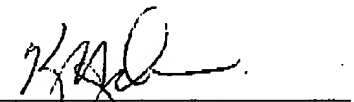
Respectfully submitted,



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